

Appl. No.: 09/330,231
Amdt. dat d: June 22, 2003
Reply to Office Action of April 22, 2003

Patent
Docket No.: 248/248
2195357051

REMARKS

Claims 1-22 stand rejected under 35 U.S.C. 103 based on "Synthesizing Converters Between Finite State Protocols" by J. Akella and K. McMillan and published in Proceedings of the International Conference on Computer Design, pp. 410-413 (October 14-15, 1991) ("Akella"). Claims 6, 8 and 21 have been amended.

Claim 1 recites "automatically synthesizing an interface between the first and second protocols based on the first and second finite automata," which is neither suggested nor disclosed by Akella.

The examiner states that, based on case law, it is well settled that it is not invention to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result, and therefore alleges that this element of claim 1 is obvious as a matter of law.

Applicants submit that the examiner's reliance on a per se rule of obviousness is an error. The examiner is apparently relying on a single statement from In re Venner, 120 USPQ 192 (CCPA 1958) to make this rejection. The examiner has used this statement out of the context of both the facts and the law of the Venner decision.

In Venner, the court identified each element of the appealed claims in the prior art. The court then decided the case based upon the principle that "if a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result." Venner at 194.

Applying the facts of Venner to the existing law for obviousness, the court held that

We are further of the opinion that the instant element recited herein as "means controlled by said time controlled means and controlling said

Appl. No.: 09/330,231
Amdt. dated: June 22, 2003
Reply to Office Action of April 22, 2003

Patent
Docket No.: 248/248
2195357051

power operated means" does not add patentability to this combination. Venner et al. together with the Nichols and Wagner patents **show the automatic means** to initiate withdrawal of a core from a piston molding apparatus; this would preclude applicants from predicated patentability on this feature....

It would be considered obvious for any person in the piston molding art to equip the multiple mold apparatus ... with time controlled means to withdraw the middle core section after a predetermined period for solidification, **in accordance with the disclosures of the secondary references....**

Venner at 194-196. (Emphasis added).

This principle was further applied by the USPTO's Board of Patent Appeals and Interferences, in Ex Parte Brouillet, Jr., Application No. 08/353,622, Appeal No. 1998-2297, which held that

The examiner argues (answer, page 4) that "it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only route in [sic, routine] skill in the art. In re Venner, 120 USPQ 192."

In In re Venner ... [the] court stated that "it is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result." Venner, 262 F.2d at 95, 120 USPQ at 194. In Venner, however, **all limitations in the claims, including the automatic means, were disclosed in the applied references.** (Emphasis added). See Venner, 262 F.2d at 96, 120 USPQ at 195.

In the present case, unlike in Venner, the examiner ... has merely relied upon a per se rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease."

When applying the principles of obviousness as described in Venner and Brouillet to the present case, in which claim 1 stands rejected based on a per se rule of obviousness, the error of

Appl. No.: 09/330,231
Amdt. dated: June 22, 2003
Reply to Office Action of April 22, 2003

Patent
Docket No.: 248/248
2195357051

this rejection becomes even more apparent. In the present case, unlike Venner, the examiner has not provided a reference which discloses "automatically synthesizing an interface between the first and second protocols based on the first and second finite automata." The examiner has merely relied upon a per se rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease."

The only teaching or suggestion of "automatically synthesizing an interface between the first and second protocols based on the first and second finite automata" as recited in claim 1 is given only by applicants' own disclosure. Applicants submit that modifying the prior art to include "automatically synthesizing an interface between the first and second protocols based on the first and second finite automata" as taught only by the present disclosure is impermissible hindsight.

Therefore, applicants submit that claim 1 is patentable over Akella. Given that claims 2-11 and 21 depend from claim 1, applicants submit that these claims are patentable over Akella in view of no secondary reference.

Claim 12 stands rejected based on Akella.

Akella neither discloses nor suggests "a synthesizing unit to automatically synthesize an interface between the first and second protocols based on the first and second finite automata," as recited in claim 12. Therefore, applicants submit that claim 12 is patentable over Akella. Given that claims 13-19 depend from claim 12, applicants submit that these claims are also patentable over Akella.

Appl. N. : 09/330,231
Amdt. dated: June 22, 2003
Reply to Office Action of April 22, 2003

Patent
Docket No.: 248/248
2195357051

Claim 20 stands rejected based on Akella.

Akella neither discloses nor suggests "automatically eliminating non-determinisms in said third representation," as recited in claim 20. Therefore, applicants submit that claim 20 is patentable over Akella.

Claim 22 stands rejected based on Akella.

Akella neither discloses nor suggests "automatically eliminating at least one non-determinism in the representation," as recited in claim 22. Therefore, applicants submit that claim 22 is patentable over Akella.

Appl. No.: 09/330,231
Amdt. dat d: June 22, 2003
Reply to Offic Acti n of April 22, 2003

Patent
Docket No.: 248/248
2195357051

CONCLUSION

Allowance of the claims is respectfully requested. The Examiner may call the Assignee's attorney at (650) 849-4422 to further advance prosecution of this case to issuance.

If the Commissioner determines that additional fees are due or that an excess fee has been paid, the Patent Office is authorized to debit or credit (respectively) Deposit Account No. 50-2518, referencing billing no. 7010602001.

DATE: July 22, 2003

Respectfully submitted,

By: 

Jeffrey Smith

Registration No. 39,377

Bingham McCutchen LLP
Three Embarcadero Center, Suite 1800
San Francisco, CA 94111
Telephone: (650) 849-4422
Telefax: (650) 849-4800